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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/03/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,512

Applicant(s)

CONKWRIGHT ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-30 are presented for examination.
2. Applicants' discussion references have been reviewed. It is requested that the references be on a form 1449 to give them proper consideration.

Specification

3. The specification is objected to because Applicants' used the acronym "IDGM" which is not understood from Applicants' specification on pages 23-25, 34, 45 as to what is meant by the acronym "IDGM". On pages 26-32, 35, 44, 45, 48-50, and 55-64 have a similar problem with the acronyms "STB". Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claim 19 is objected to because of the following informalities: Claim 19, line 4, page 68 recites "... for each of said at lest one set top boxes". This line should recite "...for each of said at least one set top boxes". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is not understood from the claim language in the steps that follow what is being done with the collected data. What do Applicants' mean to be done with the data after it is collected? Also, it is not understood what Applicants' mean by "deriving at least one user model for said at least one set top boxes." Do Applicants' mean "a certain model of the user who has the set top boxes" such as the user's demographic area, viewing preferences, gender, age, race, and income?

Please clarify to the Examiner and in the claim language.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-3, 13-19, & 23 are rejected under 35 U.S.C. 102(e) as being anticipated by (US 5,734,720) Salganicoff.

With respect to claims 1, 13, 16, 19, & 23, Salganicoff teaches, an individually targeted content delivery method comprising the steps of collecting data associated with at least one set top box (col. 3, lines 4-12); deriving at least one user model for each of said at least one set top boxes (col. 3, lines 15-19); storing said derived at least one user model and an identifier corresponding to the set top box from which said at least

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one user model is derived in a storage means for later retrieval (col. 9, lines 34-55); selecting content and associated content attributes to be delivered to at least one set top box (col. 11, lines 46-67 and col. 25, lines 40-51); transmitting said content to said set top box (col. 40, lines 38-57); and causing said content to be presented by said at least one set top box when a correlation between said content attributes and said user model associated with said set top box exists (col. 4, lines 38-64).

With respect to claim 13, collecting set top box interaction data associated with at least one set top box in a privacy compliant manner (col. 43, lines 17-65); deriving from said data at least one user model for each of said at least one set top boxes using a user demographic profile and a user interest profile determined using an inverse demographic matrix method (col. 2, lines 60-67 and col. 3, lines 1-3); selecting content and associated content characteristics to be delivered to at least one set top box (col. 4, lines 40-64).

With respect to claim 2, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said data is collected in a privacy compliant manner (col. 40, lines 59-67, col. 41, lines 1-13, col. 44, lines 34-67, and col. 45, lines 1-46).

With respect to claim 3, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein data collected from said set top box includes a record of user interaction with said set top box (col. 46, lines 16-32).

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With respect to claims 14 and 17, the individually targeted content delivery method of Claim 13, Salganicoff teaches, wherein said correlation is determined by said set top box (col. 3, lines 60-66 and col. 5, lines 19-28).

With respect to claims 15 and 18, the individually targeted content delivery method of Claim 13, Salganicoff teaches, wherein said correlation is determined prior to transmitting said content to said set top box, and wherein said transmitting step occurs only when said correlation is high enough to warrant said set top box presenting said content (col. 10, lines 8-23).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claims 4-12, 20-22, & 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salganicoff in view of (US 6,285,983 B1) Jenkins.

With respect to claim 4, Salganicoff did not teach, the individually targeted content delivery method of Claim 1, further comprising the step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used.

Jenkins discloses, the individually targeted content delivery method of Claim 1, further comprising the step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used (col. 4, lines 61-65 and col. 5, lines 9-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used and to combine Salganicoff's collecting data with Jenkins step of transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used and to modify in Salganicoff because such a modification would allow Salganicoff's system to have sophisticated direct-to-consumer marketing initiatives in a range of industries while preserving consumer privacy.

With respect to claims 5 and 7, Salganicoff teaches, the individually targeted content delivery method of Claim 1, wherein said derived user model is based on derived user interests (col. 11, lines 43-59 and col. 14, lines 24-34). Jenkins discloses, the individually targeted content delivery method of Claim 1, wherein said

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derived user model is based on derived user interests (col. 1, lines 64-67 and col. 2, lines 1-2). Together Salganicoff and Jenkins teaches the claim limitations of claim 5.

With respect to claim 6, Salganicoff teaches, the individually targeted content delivery method of Claim 1, wherein said derived user model is based on a derived user demographic profile (col. 4, lines 49-57 and col. 11, lines 60-67). Jenkins discloses, the individually targeted content delivery method of Claim 1, wherein said derived user model is based on a derived user demographic profile (col. 1, lines 41-53). Together Salganicoff and Jenkins teaches the claim limitations of claim 6.

With respect to claim 8, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said at least one set top box user model is derived using an inverse demographic matrix method (col. 9, lines 43-55) .

With respect to claim 9, The individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said content is repeatedly presented on said selected set top boxes until it has been determined that a user has experienced said content (col. 2, lines 40-59).

With respect to claims 10, 20, & 24, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said content must be experienced before user selected content can be experienced (col. 2, lines 19-47).

With respect to claims 11, 21, & 25, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said correlation is determined by said set top box (col. 3, lines 56-67 and col. 4, lines 1-9).

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With respect to claims 12, 22, & 26, the individually targeted content delivery method of Claim 1, Salganicoff teaches, wherein said correlation is determined prior to transmitting said content to said set top box, and wherein said transmitting step occurs only when said correlation is high enough to warrant said set top box presenting said content (col. 6, lines 14-59).

With respect to claim 27, a targeted advertising delivery system, comprising: Salganicoff teaches, a plurality of set top boxes (col. 5, lines 19-28); a content input means, which allows a content owner to submit content to the data center (col. 9, ;lines 43-55, col. 49, lines 10-23, and fig. 11 (step 1104); and a user model selector, which allows a content owner to select user model attributes corresponding to a group to which particular content is to be delivered (col. 49, lines 46-67 and col. 50, lines 1-16).

Salganicoff did not teach, a privacy server. However, Salganicoff discloses the at least one set top box; and a data center (col. 5, lines 19-28).

Jenkins discloses, a privacy server (col. 2, lines 61-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a privacy server, communicatively connected to the at least one set top box and a data center, communicatively connected to the privacy server and to combine Salaganicoff's set top box and data center with Jenkins privacy server communicatively connected to the set top box and data center because such

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combination would allow their systems to communicate with individual consumer's through a secure server and send information to a set top box.

With respect to claim 28, Salganicoff teaches, a set top box (col. 5, lines 19-28). However, Salganicoff did not teach, the targeted advertising delivery system of Claim 27, in which said privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes.

Jenkins discloses a privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes (col. 4, lines 48-65 and col. 5, lines 14-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes and to combine Salganicoff's set top box with Jenkins a privacy server is responsible for removing personal information from communications received from said set top box and assigning a unique code to such data for identification purposes because such a combination would allow their systems to have records that are securely stored on a secure server ensuring the privacy of individual consumers.

With respect to claim 29, Salganicoff did not teach, the targeted advertising delivery system of Claim 27, in which said data center is responsible for receiving

data and associated unique identifiers from said privacy server and determining at least one user model for each set top box based on said received data.

Jenkins discloses, the targeted advertising delivery system of Claim 27, in which said data center is responsible for receiving data and associated unique identifiers from said privacy server and determining at least one user model for each set top box based on said received data (col. 4, lines 34-58 and col. 6, lines 33-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the data center responsible for receiving data and associated unique identifiers from said privacy server and determining at least one user model for each set top box based on said received data and to combine Salganicoff's set top box with Jenkins privacy server and unique identifiers because such a combination would allow their systems to have some data element that uniquely identifies and individual consumer with the system communicating through communications facilities in order to acquire and store the consumer data.

With respect to claim 30, Salganicoff and Jenkins did not teach, a computer readable program code. However, a computer readable program code is inherent to the system to perform the steps of claim 30 involving collecting set top box events, deriving a user model in a database of user models, storing the content to be delivered to a set top box, selecting from the stored user models and the stored content of those user models and content which have a high degree of correlativity and transmitting the selected content to a set top box associated with the selected

user model, and presenting the content via the set top box. A computer readable program code is well known in the art as being configured to record and to store device environment configuration information in a development system configuration managed by the operating system of the host computer to a data storage medium comprising computer readable program code that is configured to specify device information for a desired device.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McKenna et al (US 4,546,382) disclosed market research and data collection.

Watanabe et al (US 4,905,080) disclosed market research data and collecting television channel data.

Dedrick (US 5,710,884) disclosed monitoring user's consuming habits.

Nielsen, Jakob, Hardman, Lynda, Nicol, Anne, Yankelovich, Nicole, "Panel: The Nielsen Ratings: Hypertext Reviews" disclosed the four categories of review for hypertext documents according to the Nielsen ratings.

Davis et al (US 5,796,952) disclosed tracking client interaction with a network resource and client profiles.

Middleton, III et al (US 6,393,407) disclosed tracking user micro-interactions with web page advertising.

Thomas L., William discloses television audience research using Nielsen ratings.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non-Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read "E. Colbert", is positioned to the right of the text block.

August 29, 2002